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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _24 November 2008_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-24_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   In the amendment filed 11/24/2008, the following occurred: Claims 12, 18, and

19 were amended, and claims 22-24 were added. Claims 1-24 are presented for

examination.

Response to Amendments

2.   The rejection of claim 18 under 35 U.S.C. 112, second paragraph, is withdrawn

in view of corrective amendment. The amendments and new claims appear to not add

new subject matter and will be treated below on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1-19 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent Application Publication 2002/0143469 to Alexander et al. in view of U.

S. Patent 6,985,872 to Benbassat et al.

4.   As per claim 1, Alexander et al. teaches a method of calculating a risk exposure

for a disaster recovery process, said method comprising:

        --loading a user interface (see: Alexander et al., paragraphs 38, 65, 74, 75, 78,

93) *into a memory* (see: Alexander et al., paragraphs 81, and 93),

        --a specific disaster type (see: Alexander et al., paragraph 1),

Alexander et al. fails to teach:

--said user interface allowing control of an execution of one or more risk models, each said risk model being based on a specific disaster type, each said risk model addressing a recovery utilization of one or more specific assets identified as necessary for a recovery process of said disaster type; and

However, Benbassat et al. teaches simulating the distribution of assets over hypothetical demand samples forecasted using statistical demand characteristics obtained from historical data (see: Benbassat et al., column 10, lines 41-55). Furthermore, miscalculation in the distribution of the assets represents a risk (see: Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to predict problems and check possible solutions" (see: Benbassat et al., column 10, lines 30-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Alexander et al. and Benbassat et al. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

--executing, at least one time, one of said risk models (see: Benbassat et al., column 10, line 59 through column 11, line 3).

5.   As per claim 2, Alexander et al. teaches the invention substantially as claimed, see discussion of claim 1, and further teaches:

*--loading at least one of said risk models into one of a local computer memory
and a local memory of a computer at a remote location, said loading allowing said
executing of said model* (see: Alexander et al., paragraphs 11, 36, 38, 54, 57, 58, 60,
65, 68, 69, 73-76, 78, 81, 93).

6.   As per claim 3, Alexander et al. teaches the invention substantially as claimed,
see discussion of claim 1, and further teaches:

--at least one of said risk models is based on a Poisson distribution function (see:
Benbassat et al., column 10, lines 51-55, is met by "[a] stochastic method is used to
generate of hypothetical samples" of expected demands on assets, and a stochastic
method would include a Poisson process based on a Poisson distribution function).

7.   As per claim 4, Alexander et al. teaches the invention substantially as claimed,
see discussion of claim 1, and further teaches:

--specific disaster type comprises at least one of a: hurricane (see: Alexander et
al., paragraph 1); *earthquake; flood; and power outage.*

8.   As per claim 5, Alexander et al. teaches the invention substantially as claimed,
see discussion of claim 1, and further teaches:

*--risk models include at least one of: an overall risk exposure that assess a risk
that said one or more specific assets will be adequate to recover from said disaster*
(see: Benbassat et al., column 10, lines 58-63, is met by aggregated results are
checked to see if the resources matched demand); *a disaster outlook to assess a
consequence of a recent or anticipated disaster at a specific location; and a customer
risk assessment to access a risk for an individual customer.*

9.   As per claim 6, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 1, and further teaches:

        --*each said risk model includes at least one parameter selectable in a random*

manner (see: Benbassat et al., column 10, lines 52-54).

10.   As per claim 7, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 2, and further teaches:

        --*at least one of said GUI and said risk models are stored in a remote computer*

and said loading comprises a transfer of at least said GUI to a local computer (see:

Alexander et al., paragraphs 11, 36, 38, 54, 57, 58, 60, 65, 68, 69, 73-76, 78, 81, 93).

11.   As per claim 8, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 6, and further teaches:

        --*executing said model a number of times, each execution based on a random*

setting of at least one said parameter selectable in a random manner (see: Benbassat

et al., column 10, line 52 through column 11, line 3).

12.   As per claim 9, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 8, and further teaches:

        --*said number of times is established by at least one of: entering a number of*

runs to be executed (see: Benbassat et al., column 11, lines1-3); *and entering an*

accuracy of a result, said accuracy causing said model to be executed repeatedly until

said accuracy is attained.

13.   As per claim 10, Alexander et al. teaches an apparatus configured to calculate a

risk exposure for a disaster recovery process, said apparatus comprising:

--*a user interface allowing control of an execution of* (see: Alexander et al.,

paragraphs 38, 65, 74, 75, 78, 93)

--*a specific disaster type* (see: Alexander et al., paragraph 1),

Alexander et al. fails to teach:

--*one or more risk models, each said risk model being based on a specific*

disaster type, each said risk model addressing a recovery utilization of one or more

specific assets identified as necessary for a recovery process of said disaster type; and

However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 10, lines 41-55).

Furthermore, miscalculation in the distribution of the assets represents a risk (see:

Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to

predict problems and check possible solutions" (see: Benbassat et al., column 10, lines

30-34). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander et al. and Benbassat et al.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

--*an execution command switch for commanding an execution of at least one of*

said risk models (see: Benbassat et al., column 10, line 59 through column 11, line 3).

14.   As per claim 11, Alexander et al. teaches a network configured to calculate a

risk exposure for a disaster recovery process, said network comprising at least one of:

    --a first computer having: a user interface (see: Alexander et al., paragraphs 38,

65, 74, 75, 78, 93)

    --a specific disaster type (see: Alexander et al., paragraph 1),

    Alexander et al. fails to teach:

    --allowing control of an execution of one or more risk models, each said risk

model being based on a specific disaster type, each said risk model addressing a

recovery utilization of one or more specific assets identified as necessary for a recovery

process of said disaster type; and

    However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 10, lines 41-55).

Furthermore, miscalculation in the distribution of the assets represents a risk (see:

Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to

predict problems and check possible solutions" (see: Benbassat et al., column 10, lines

30-34). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander et al. and Benbassat et al.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

--an execution command switch for commanding an execution of at least one of

said risk models (see: Benbassat et al., column 10, line 59 through column 11, line 3);

and

--a second computer having a memory storing at least one of said risk models

(see: Alexander et al., paragraphs 11, 36, 38, 54, 57, 58, 60, 65, 68, 69, 73-76, 78, 81,

93).

15.   As per claim 12, Alexander et al. teaches a <u>tangible</u> signal-bearing <u>storage</u>

medium tangibly embodying a program of machine-readable instructions executable by

a digital processing apparatus to perform a method of calculating a risk exposure for a

disaster recovery process, said method comprising:

--loading a user interface (see: Alexander et al., paragraphs 38, 65, 74, 75, 78,

93) *into a memory* (see: Alexander et al., paragraphs 81, and 93),

--a specific disaster type (see: Alexander et al., paragraph 1),

Alexander et al. fails to teach:

--said user interface allowing control of an execution of one or more risk models,

each said risk model being based on a specific disaster type, each said risk model

addressing a recovery utilization of one or more specific assets identified as necessary

for a recovery process of said disaster type; and

However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 10, lines 41-55).

Furthermore, miscalculation in the distribution of the assets represents a risk (see:

Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to

predict problems and check possible solutions" (see: Benbassat et al., column 10, lines

30-34). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander et al. and Benbassat et al.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

   --executing, at least one time, one of said risk models (see: Benbassat et al.,

column 10, line 59 through column 11, line 3).

16.   As per claim 13, Alexander et al. teaches a method of objectively quantifying

consequences of an event, said method comprising:

   --a memory (see: Alexander et al., paragraphs 81, and 93)

   Alexander et al. fails to teach:

   --loading one or more models concerning said event into a memory, at least one

of said models predicting a consequence of said event, said predicting based on an

historical data of said event;

   However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 10, lines 41-55).

Furthermore, miscalculation in the distribution of the assets represents a risk (see:

Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to

predict problems and check possible solutions" (see: Benbassat et al., column 10, lines 30-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Alexander et al. and Benbassat et al. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

--*executing at least one of said risk models a plurality of times, each time using at least one parameter that is selected at random* (see: Benbassat et al., column 10, line 52 through column 11, line 3); *and*

--*using a result of said executing to quantify a probability of a consequence of said event* (see: Benbassat et al., column 10, lines 58-62).

17.   As per claim 14, Alexander et al. teaches the invention substantially as claimed, see discussion of claim 13, and further teaches:

--*event comprises a disaster* (see: Alexander et al., paragraph 1).

18.   As per claim 15, Alexander et al. teaches the invention substantially as claimed, see discussion of claim 14, and further teaches:

--*consequence comprises a utilization of resources* (see: Benbassat et al., column 10, lines 58-62) *provided by a disaster recovery service* (see: Alexander et al., paragraphs 1, 5, 35, 37, 81, and 82, is met by "emergency management centers (EMCs)").

19.   As per claim 16, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 15, and further teaches:

        --*resources comprise at least one of a use of a computer and a use of a*

computer-related component (Fig. 5)(see: Alexander et al., paragraphs 11, 36, 38, 54,

57, 58, 60, 63, 65, 68, 69, 73-76, 78, 81, 93).

20.   As per claim 17, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 13, and further teaches:

        --*at least one of said models is based on a probability function having parameters*

approximating an historical data of the occurrence of said event (see: Benbassat et al.,

column 10, lines 41-55).

21.   As per claim 18, Alexander et al. teaches a <u>tangible </u>signal-bearing <u>storage</u>

medium tangibly embodying a program of machine-readable instructions executable by

a digital processing apparatus to perform a method of objectively quantifying

consequences of event<u>s</u>, said method comprising:

        --*loading into a memory* (see: Alexander et al., paragraphs 38, 65, 74, 75, 78, 81,

and 93),

        Alexander et al. fails to teach:

        --*one or more models concerning <u>an</u> event*

        --*at least one of said models being based on predicting a consequence of said*

event, as based on an historical data of said event;

        However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 1, lines 41-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Alexander et al. and Benbassat et al. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

--executing at least one of said risk models a plurality of times, each time using at least one parameter that is selected at random (see: Benbassat et al., column 10, line 52 through column 11, line 3); *and*

--using a result of said executing to quantify a probability of a consequence of said event (see: Benbassat et al., column 10, lines 58-62).

22.   As per claim 19, Alexander et al. teaches the invention substantially as claimed, see discussion of claim 18, and further teaches:

--at least one of said models is based on a probability function having parameters approximating an historical data of the occurrence of said event (see: Benbassat et al., column 1, lines 41-55).

23.   As per claim 23, Alexander et al. teaches the invention substantially as claimed, see discussion of claim 1, and further teaches:

--wherein each said risk model comprises statistical models that describe a probability that a customer will declare a disaster, given attributes of the customer and

attributes of the disaster event (see: Benbassat, in column 10, lines 58-63, is met by the

aggregated results being checked to see if the resources matched demand).

24.   **Claims 20 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent Application Publication 2002/0143469 to Alexander et al. in view of U.

S. Patent 6,985,872 to Benbassat et al. further in view of Examiner's Official Notice.

25.   As per claim 20, Alexander et al. teaches a method of operating a disaster

recovery service, said method comprising:

     --a disaster recovery process (see: Alexander et al., paragraphs 1, 5, 35, 37, 81,

and 82, is met by the actions of "emergency management centers (EMCs)")

     --a specific disaster type (see: Alexander et al., paragraph 1)

     Alexander et al. fails to teach:

     --acquiring access to a tool that calculates a risk exposure for a disaster recovery

process, said tool having one or more risk models, each said risk model being based on

a specific disaster type, each said risk model addressing a recovery utilization of one or

more specific assets identified as necessary for a recovery process of said disaster

type; and

     However, Benbassat et al. teaches simulating the distribution of assets over

hypothetical demand samples forecasted using statistical demand characteristics

obtained from historical data (see: Benbassat et al., column 1, lines 41-55).

Furthermore, miscalculation in the distribution of the assets represents a risk (see:

Benbassat et al., column 1, lines 34-37), which is why simulating is valuable "in order to

predict problems and check possible solutions" (see: Benbassat et al., column 10, lines

30-34). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander et al. and Benbassat et al.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

The references do not specifically teach:

--advertising that said disaster recovery service utilizes said tool as a technique

to control an inventory of said assets.

However, the Examiner takes Official Notice that advertising a product was old

and well known to a person of ordinary skill in the art at the time the invention was

made. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine advertising as taught by the Examiner's Official Notice

and the teachings of Alexander et al. and Benbassat et al. The well known elements

described are merely a combination of old elements, and in the combination, each

element merely would have performed the same function as it did separately, and one

of ordinary skill in the art would have recognized that the results of the combination

were predictable.

26.   As per claim 21, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 20, and further teaches:

--at least one of the following: assessing a risk against a real inventory and a

sum of all contracts; allocating a cost of a contract as a result of calculating a probability

of a disaster in a location; assessing an asset requirement before a predicted disaster

actually strikes a location; locating assets to overcome a predicted asset shortage

based on a prediction of occurrence of a disaster (see: Benbassat et al., column 2, lines

4-11); *and offering price point differentials to customers located outside a high-risk*

disaster area.

27.   **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Application Publication 2002/0143469 to Alexander et al. in view of U. S. Patent

6,985,872 to Benbassat et al. further in view of U.S. Patent Application Publication

2004/0260703 to Elkins.

28.   As per claim 22, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 1, but fails to specifically teach the limitation of claim 22,

however, Elkins teaches:

     --wherein each said risk model comprises a pre-calculated statistical expression

(see: Elkins, paragraphs 21, 28, and 29), *derived from a statistical analysis of historical*

data of disaster events (see: Elkins, paragraphs 21, 24, 28, and 29), *of a frequency and*

patterns of occurrence of each type of disaster event (see: Elkins, paragraphs 30-32),

expressed as values of location and severity attributes of each type of disaster event

(see: Elkins, paragraphs 21, 25, 30-32, 40, 42, and 43).

     It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander, Benbassat, and Aratow.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

29.   **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Application Publication 2002/0143469 to Alexander et al. in view of U. S. Patent

6,985,872 to Benbassat et al. further in view of U.S. Patent 7,448,079 to Tremain.

30.   As per claim 24, Alexander et al. teaches the invention substantially as claimed,

see discussion of claim 1, but fails to specifically teach the limitation of claim 24,

however, Tremain teaches:

--wherein said disaster recover process relates to a disaster recover service that

comprises a business that provides computer facilities to contractual customers who

seek recovery services in an aftermath of disasters or an anticipation of disasters (see:

Tremain, column 6, lines 40-44).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Alexander, Benbassat, and Tremain.

The well known elements described are merely a combination of old elements, and in

the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of

the combination were predictable.

Response to Arguments

31.   Applicant's arguments from the response filed on 10/10/2008 have been fully

considered and will be addressed below in the order in which they appeared.

32.   In the remarks, Applicant argues in substance that (1) "The examiner asserts that

"Alexander teaches a method of calculating a risk exposure". This is factually incorrect:

as noted above, nothing in Alexander has anything to do with calculating risk

exposure."; that (2) "The examiner further asserts that the said method of calculating a

risk exposure is "for a disaster recovery process". This is not relevant: as noted above,

the "disaster recovery process" of Alexander is very different from the "disaster recovery

service" of the present invention."; that (3) "The examiner acknowledges that Alexander

fails to teach "execution of one or more risk models ...", but asserts that this is contained

in Benbassat. This is factually incorrect: as noted above, Benbassat does not include

anything that could be regarded as a risk model."; that (4) "The examiner asserts that it

would have been obvious to one of ordinary skill in the art to combine the teachings of

Alexander and Benbassat. This is clearly incorrect, since the subject areas of these two

references are very different both from each other and from the subject area of the

present invention. Furthermore, neither Alexander nor Benbassat teaches the

calculation of a risk exposure, so combining Alexander and Benbassat still does not

yield all the content of the claimed invention."; and that (5) "Relative to the rejection for

claims 20 and 21, the Examiner invokes Official Notice, alleging that "advertising a

product was old and well known to a person of ordinary skill in the art.. .." However,

merely "advertisinn a product" does not satisfy the plain meaning of the claim language

of claim 20. That is, this claim requires: ". . . advertising that said disaster recovery

service utilizes said tool as a technique to control an inventory of said assets."

Therefore, the Examiner invocation of Official Notice is not sufficient to demonstrate this

claim, and Applicants request that the Examiner provide of record a combinable

reference that demonstrates the plain meaning of this claim language."

33.   In response to Applicant's argument that (1) "The examiner asserts that

"Alexander teaches a method of calculating a risk exposure". This is factually incorrect:

as noted above, nothing in Alexander has anything to do with calculating risk

exposure.", the Examiner respectfully disagrees.

Applicant's argument is not found persuasive. In response to Applicant's

arguments alleging that Alexander does not teach specifically "a method of calculating a

risk exposure", the limitation is not given patentable weight because the recitation

occurs in the preamble. A preamble is generally not accorded any patentable weight

where it merely recites the purpose of a process or the intended use of a structure, and

where the body of the claim does not depend on the preamble for completeness but,

instead, the process steps or structural limitations are able to stand alone. See *In re*

Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,

152, 88 USPQ 478, 481 (CCPA 1951). An examination of claim 1 reveals that

calculating "risk exposure" is never taught in the body of the claim. Instead, loading a

user interface that runs a risk model based on certain criteria and running that model is

taught. If indeed Applicant believes this to be the invention's point of novelty, it should

be included in the independent claim. Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to

Applicant's arguments against the Alexander reference individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references, in this case, a combination of Alexander and Benbassat. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Applicant seems to argue the intended use of the claimed invention which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

34.   In response to Applicant's argument that (2) "The examiner further asserts that the said method of calculating a risk exposure is "for a disaster recovery process". This is not relevant: as noted above, the "disaster recovery process" of Alexander is very different from the "disaster recovery service" of the present invention.", the Examiner respectfully disagrees.

Applicant's argument is not found persuasive. In response to Applicant's arguments alleging that Alexander does not teach specifically that the intended use of his invention is "for a disaster recovery process", the limitation is not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore,

even if the limitation of stipulating that the invention is "for a disaster recovery process" was included in the body of the claims, such a recitation is a declaration of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In response to Applicant's arguments against the Alexander reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, in this case, a combination of Alexander and Benbassat. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

35.   In response to Applicant's argument that (3) "The examiner acknowledges that Alexander fails to teach "execution of one or more risk models ...", but asserts that this is contained in Benbassat. This is factually incorrect: as noted above, Benbassat does not include anything that could be regarded as a risk model.", the Examiner respectfully disagrees.

In pages 10 and 11 of the remarks, Applicant states further that Benbassat "describes a method that includes simulating scenarios of further claims on resources", but objects to notion that Benbassat teaches "anything that could be regarded as a "risk model"" because Benbassat's "forecasts and simulations are of "a *typical* day's demands"" and use "specific components".

Applicant's argument is not found persuasive. Benbassat does indeed teach simulating scenarios of further claims on resources. Benbassat determining "statistical demand characteristics obtained from historical data" that "describe demand" by using a "stochastic method…to generate a number of hypothetical samples of a typical day's demands, randomly drawn according to the statistical distributions", and aggregating the detailed results and checking "whether the resources indeed matched the demand under simulated fully-detailed operation" (see: Benbassat, column 10, lines 28-68). This "simulation", as Benbassat calls it, meets Applicant's claimed "risk model". That the simulations are of "a typical day's demands" and use "specific components" must be read in the context of the combination of Benbassat and Alexander and is incident thereof. Alexander teaches the disaster and the associated database of baseline data including resources to be allocated according to the Benbassat simulation (see: Alexander, paragraphs 1 and 37-39). In response to applicant's arguments against the Benbassat reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

36.   In response to Applicant's argument that (4) "The examiner asserts that it would have been obvious to one of ordinary skill in the art to combine the teachings of Alexander and Benbassat. This is clearly incorrect, since the subject areas of these two references are very different both from each other and from the subject area of the present invention. Furthermore, neither Alexander nor Benbassat teaches the

calculation of a risk exposure, so combining Alexander and Benbassat still does not

yield all the content of the claimed invention.", the Examiner respectfully disagrees.

Applicant's argument is not found persuasive. In response to Applicant's

argument that Alexander and Benbassat are nonanalogous art, it has been held that a

prior art reference must either be in the field of Applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the Applicant was concerned,

in order to be relied upon as a basis for rejection of the claimed invention. See *In re*

Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Alexander is

directed towards an emergency management system for aiding resource allocation in a

disaster recovery situation, and Benbassat is directed towards simulating scenarios of

future claims on resources. Applicant teaches simulating a scenario that will require a

demand on available resources in the case of a disaster recovery situation. The

Alexander and Benbassat references reasonable pertain to the particular problem with

which Applicant is concerned and were correctly combined as per MPEP 2141 (III) to

meet the claimed invention.

As per the calculation of a risk exposure, this is an intended use recitation found

in the preamble of claim 1, neither of which (intended use or preamble), as stated

above, are given much patentable weight. The closest that Applicant comes to claiming

this limitation is in dependent claim 5, where it is stated that the risk model includes "an

overall risk exposure", and even then, this is one option factor out of three due to the "at

least one of" stipulation; and in independent claim 20, where it is claimed: "acquiring

access to a tool", a tool "that calculates a risk exposure", but here the step of calculating

a risk exposure is not positively recited in the method claim, only acquiring access to a

tool that is capable of performing such action. As per these types of limitations, it has

already been cited to Applicant in the previous Office action that Benbassat, in column

10, lines 58-63, meets this limitation by stipulating that the aggregated results are

checked to see if the resources matched demand. Furthermore, the next few lines of

Benbassat teach reallocating resources to meet an appropriate, or desired, "level". That

the simulations reveal a level indicating appropriateness of resource allocation meets

the limitation of calculating an overall risk exposure. Furthermore, with regard to this

argument in the remarks, Applicant focuses on how the Alexander reference, in

isolation, does not teach the claimed invention; however, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references, in this case, a combination of Alexander and Benbassat.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

37.   In response to Applicant's argument that (5) "Relative to the rejection for claims

20 and 21, the Examiner invokes Official Notice, alleging that "advertising a product was

old and well known to a person of ordinary skill in the art...." However, merely

"advertising a product" does not satisfy the plain meaning of the claim language of claim

20. That is, this claim requires: ". . . advertising that said disaster recovery service

utilizes said tool as a technique to control an inventory of said assets." Therefore, the

Examiner invocation of Official Notice is not sufficient to demonstrate this claim, and

Applicants request that the Examiner provide of record a combinable reference that

demonstrates the plain meaning of this claim language.", the Examiner respectfully disagrees.

Applicant's argument is not found persuasive. Applicant has attempted to challenge the Examiner's taking of Official Notice in the Office Action mailed 08/22/2008. There are minimum requirements for a challenge to Official Notice:

(a)   In general, a challenge, to be proper, must contain adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice.

(b)   Applicants must seasonably traverse (challenge) the taking of Official Notice as soon as practicable, meaning the next response following an Office Action. If an applicant fails to seasonably traverse the Official Notice during examination, his right to challenge the Official Notice is waived.

Applicant has not provided adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Bald statements such as, "merely "advertising a product" does not satisfy the plain meaning of the claim language" and "the Examiner invocation of Official Notice is not sufficient to demonstrate this claim", are not adequate and do not shift the burden to the Examiner to provide evidence in support of the Official Notice.

However, the Examiner will comply with "Applicants request that the Examiner provide of record a combinable reference that demonstrates the plain meaning of this

claim language" to show that advertising a product was old and well known to a person

of ordinary skill in the art at the time the invention was made. See: U.S. Patent

7,478,047 to Loyall, column 4, line 63 through column 5, line 2, is met by advertising a

product.

Conclusion

38.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

39.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

40.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ROBERT SOREY whose telephone number is

(571)270-3606. The examiner can normally be reached on Monday through Friday,

8:30AM to 5:00PM (EST).

41.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christopher Gilligan can be reached on (571)272-6770. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

42.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./
Examiner, Art Unit 3626
29 January 2009

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626